



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

m

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/710,022

06/14/2004

James S. Bronner

NB01

4021

27797

7590

05/23/2006

RICHARD D. FUERLE

1711 W. RIVER RD.

GRAND ISLAND, NY 14072

EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,022

Applicant(s)

BRONNER, JAMES S.

Examiner

Christopher R. Tate

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1655

DETAILED ACTION

Claims 1-20 are presented for examination on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin (US 2005/0276839 - please note that the effective filing date of this reference is June 10, 2004 - based upon the provisional filing date) and Tulp et al. (FASEB Journal Abstract, 2001 - including BIOSIS Abstract) in view of Susumu (JP 05255100 - including DWPI Abstract and the full computer-assisted English translation) and Inoue et al. (EP 0930019), and further in view of Yang (CN 1164391).

A weight-loss composition comprising amount ranges of aqueous *Hoodia gordonii* and *Cassia nomame* preparations therein is claimed, as is a method of losing weight therewith via administering at least one serving of the weight-loss composition prior to eating. Dependent claims include the composition further comprising (or optionally further comprising) glycerin, menthol, an acid, a flavoring agent, and/or a flavoring enhancer, as well as a sealable container containing the weight-loss composition.

Art Unit: 1655

The Rifkin and Tulp references each beneficially teach weight-loss compositions comprising an aqueous preparation of *Hoodia gordonii* as an active appetite-suppressant therein (see entire documents). Rifin further discloses various aqueous (beverage) *Hoodia gordonii*-containing compositions (supplied within sealed containers - i.e., easy-to-open containers) each of which has a pH within the instantly claimed pH ranges (including via the addition of an acid or acid salt), as well as the addition of ascorbic acid, citric acid, natural flavoring agents, menthol, and/or flavor enhancers (e.g., fructose) thereto (see entire Rifkin document including, e.g., paragraphs [0009], [0013], [0020], [0021], [0038], [0049], [0053], [0055], [0056], [0058], [0062], Examples, claims). Neither of these references teaches the further inclusion of *Cassia nomame* therein.

Susumu and Inoue et al. each beneficially teach anti-obesity (weight-loss) compositions comprising an aqueous *Cassia nomame* (which Susumu also terms Sanpenzu; and which Inoue et al. terms *Cassia mimosoides* L. var. *nomame* - please note that the latter botanical name is synonymous with *Cassia nomame*) preparation as an active (lipase-inhibitor) ingredient therein (see, e.g., Susumu - DWPI Abstract, as well as the full computer-assisted English translation thereof; Inoue - entire document including Abstract, Examples, claims). None of these references expressly teach the inclusion of certain other claimed ingredients such as glycerin therein.

Yang beneficially teaches the inclusion of glycerin within a weight-loss composition (see DWPI abstract).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well

Art Unit: 1655

known in the art for the same purpose and for the following reasons. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose (as well as to utilize such a combination of ingredients for such art-recognized purpose - i.e., for losing weight). The idea for combining them flows logically from their having been used individually in the prior art. In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. The result-effective adjustment of particular conventional working conditions (e.g., determining an appropriate amount of one or more of the reference-cited weight-loss ingredients to incorporate therein, when to administer such a composition - such as just prior to eating, utilizing a particular *Hoodia gordonii* extract - such as one having a particular spectral absorbance, and/or including commonly-employed natural cherry flavoring therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Art Unit: 1655

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher R. Tate
Primary Examiner
Art Unit 1655